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Peter Kamvysselis

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MUIRHEAD AND SATURNELLI, LLC
200 FRIBERG PARKWAY, SUITE 1001
WESTBOROUGH, MA 01581

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TANG, KENNETH

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER KAMVYSSELIS, DAN ARNON, DAVID MEIRI and
MARK J. HALSTEAD

Appeal 2008-0706
Application 09/891,143
Technology Center 2100

Decided: September 2, 2008

Before JAMES D. THOMAS, ALLEN R. MACDONALD, and
THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-6, 17-22, and 27. We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

According to Appellants, the invention relates to communication between storage devices (Spec. 1, ll. 8-9).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. A method of providing multiple jobs for a first communication device that exchanges data with a second communication device, comprising:

providing a plurality of device records, wherein each of the device records corresponds to the first communication device;

providing a plurality of job records for at least one of the device records, wherein each of the job records contains at least some information that is also provided in the corresponding one of the device records and wherein at least one of the job records corresponds to tasks performed in connection with exchanging data between the first communication device and the second communication device; and

linking the job records and the corresponding device record so that any one of the job records may be accessed by first accessing the corresponding one of the device records, wherein jobs corresponding to the job records associated with a particular device record are serviceable by different entities.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Poublan	US 4,104,718	Aug. 1, 1978
Brackett	US 6,519,632 B1	Feb. 11, 2003
Atkin	US 5,900,871	May 4, 1999
James	US 6,035,376	Mar. 7, 2000

Claims 1, 5, 6, 17, 21, 22, and 27 stand rejected under 35 U.S.C. § 103(a) over the teachings of Poublan, Brackett, and Atkin.

Claims 2-4, and 18-20 stand rejected under 35 U.S.C. § 103(a) over the teachings of Poublan, Brackett, and James.

We affirm.

II. ISSUES

The issues are whether Appellants have shown that the Examiner erred in finding that:

A. claims 1, 5, 6, 17, 21, 22, and 27 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Poublan, Brackett, and Atkin, and in particular, the combination of Poublan, Brackett, and Atkin discloses that “jobs corresponding to the job records associated with a particular device record are serviceable by different entities” (Claim 1); and

B. claims 2-4, and 18-20 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Poublan, Brackett, and James.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Poublan

1. Poublan discloses an arrangement for sharing file information among plural processes in a multiprogrammed computing system (Abstract), in which files may be either “assigned” to jobs or “cosigned” to jobs. An Assign File Table (AFT) is located in a subfile SCR which contains an entry for each internal file name and index to which will be assigned either device, devices with a file, or devices with volumes (col. 40, ll. 3-19; fig. 19).
2. Subfile PGFD 944 includes blocks which describe the job’s use of a file, the job’s use of a device, the pool of devices associated with a file (col. 56, ll. 35-57).

Brackett

3. Brackett discloses a network having an ultrasound scanner 24, a worklist broker 25, N storage devices 26, and M printing devices 28, connected to a LAN 30. The invention of Brackett is incorporated in the ultrasound scanner having the built-in capability to communicate with any one or more of the devices 25, 26, and 28 (col. 8, ll. 5-16; fig. 2).

Atkin

4. Atkin discloses a computer system having at least one processor 10. Processor 10 is interconnected via system bus 12 to random access memory 16, read only memory 14, and input/output adapter 18 for connecting peripheral devices such as disk units 20, tape drives 40 to bus 12, user interface adapter 22, communication adapter 34 for connecting the information handling system to a data processing network, and display adapter 36. Communication adaptor 34 may link the system with hundreds or even thousands of similar systems, or other devices, such as remote printers, remote servers, or remote storage units (col. 5, ll. 1-15; fig. 1).

IV. PRINCIPLES OF LAW

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). Our reviewing court has repeatedly warned against confining the

claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc).

However, nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

V. ANALYSIS

Combinability under 35 U.S.C. §103

The Examiner found that one of ordinary skill in the art would have found it obvious to combine the teachings of Pouban, Brackett, and Atkin, as set forth beginning at page 4 of the Answer, which complies with the requirements of the above-noted case law. The Appellants provide no argument to dispute that the Examiner has correctly shown that it would have been obvious to combine the references. Thus, we deem those arguments waived.

Claims 1, 5, 6, 17, 21, 22, and 27

Appellants do not provide separate arguments with respect to the rejection of claims 1, 5, 6, 17, 21, 22, and 27. Therefore, we select independent claim 1 as being representative of the cited claims. 37 C.F.R. § 41.37(c)(1)(vii).

Appellants argue that the cited references do not disclose a feature “where jobs corresponding to the job records associated with a particular device record are serviceable by different entities” (App. Br. 9). In particular, Appellants argue that “none of the cited reference appears to address or even recognize [the] problem solved by [Appellants’] claimed invention” which “facilitates operations for a device being handled more quickly and efficiently by allowing multiple entities (including entities that are relatively idle) to assist in servicing jobs” (App. Br. 9) since “it is possible for a single entity (like a communication adaptor) to *service* multiple jobs from multiple sources while at the same time those jobs are *serviceable* by only that entity” (App. Br. 8).

Appellants’ argument that the cited references do not address or recognize the problem solved by Appellants’ invention is not commensurate with the claimed invention. Such problem recognition cannot be read into the claims where the claims do not recite such limitation. The issue we address on appeal is whether the combination of Pouban, Brackett, and Atkin discloses that “jobs corresponding to the job records associated with a particular device record are serviceable by different entities” (Claim 1).

We begin our analysis by giving the claims their broadest reasonable interpretation. *See In re Bigio* at 1324. Furthermore, our analysis will not read limitations into the claims from the specification. *See In re Van Geuns* at 1184. It is the Appellants’ burden to precisely define the invention. *See In re Morris* 127 F.3d 1048, 1056 (Fed. Cir. 1997).

Appellants' claims simply do not place any limitation on what the "serviceable" feature is to be, to represent, or to mean, other than that the jobs are serviceable by different entities. Thus, we construe the term "serviceable" by giving the term its customary and ordinary meaning of "capable of being serviced." Accordingly, we construe "serviceable by different entities" to be jobs that are capable of being serviced by different entities. In fact, the Appellants also admit that "a task or job may be said to be *serviceable* by more than one entity... if more than one entity can do the processing corresponding to the task or job" (App. Br. 8).

We agree with the Examiner's finding that Pouban, Brackett, and Atkin disclose the claimed elements on appeal beginning at page 3 of the Answer, and including the Examiner's corresponding responsive arguments beginning at page 7 of the Answer and page 4 of the Supplemental Answer.

As the Examiner found, Pouban discloses "providing multiple jobs for a device associated with a communication device" (Supp. Ans. 4; FF 1-2). Also, "Brackett teaches having job records containing information that is also provided in the corresponding one of the device records for a system that communicates with multiple remotely located storage or printing devices" (Supp. Ans. 4; FF 3). Further, "Atkin teaches that it is typical and well known in the art for a computer system to have entities such as adaptors," and that "Atkins also discloses another entity such as a communication adaptor 34, wherein it transfers data and links the device

with hundreds or even thousands of similar devices such as remote printers, remote servers, or remote storage units” (Supp. Ans. 4-5; FF 4).

We agree with the Examiner that the combination of Poublin, Brackett, and Atkin discloses linking the job records and the corresponding device record so that any one of the job records may be accessed by first accessing the corresponding one of the device records, wherein jobs corresponding to the job records associated with a particular device record are serviceable by different entities.

Though Appellants argue that it is possible for a single entity to service multiple jobs while at the same time those jobs are serviceable by only that entity, the Appellants also admit that “a task or job may be said to be *serviceable* by more than one entity... if more than one entity can do the processing corresponding to the task or job” (App. Br. 8). As the Examiner found, Atkin “teaches the capability of sending print jobs to a remote printer through a communication adapter, thus satisfying the Applicants’ own interpretation of the term ‘serviceable’” (Ans. 8).

Atkin discloses that the communication adaptor links the device with hundreds or even thousands of similar devices such as remote printers, remote servers, or remote storage units (FF 4). We thus agree that such task or job of the combined teachings of Poublin, Brackett and Atkins would be serviceable by more than one of the remote entities. That is, at least more than one of the hundreds or thousands of the remote printers, servers, or storage units could have serviced the job.

Additionally, we note that the term “serviceable” in “serviceable by different entities” is a nonfunctional descriptive material that is not functionally related to the step of “linking the job records.” Such “serviceable” feature does not change the functionality of or provide an additional step to the “linking” step of the claimed method, but rather, is a determination that may be made by the human user. When the descriptive material is not functionally related to the claimed step, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See *In re Ngai* at 1339 and *In re Gulack* at 1385. Accordingly, we find that Appellants’ limitation of “serviceable by different entities” does not distinguish the claims from the combination of Pouban, Brackett, and Atkin in terms of patentability.

Appellants also argue “even though Atkins teaches use of a communication adaptor (34), Atkins does not appear to teach any job records for servicing the adaptor” (App. Br. 10), and that “Atkins discloses only the processor (10) that could possibly service those jobs (App. Br. 10-11). Appellants appear to be arguing that individually Atkin does not disclose the claimed invention. However, the Examiner has rejected the claims based on the combination of Pouban, Brackett, and Atkin, and nonobviousness cannot be shown by attacking the references individually. See *in re Merck & Co., Inc.* at 1097.

As discussed above, as the Examiner found, Poublin discloses providing multiple jobs for a device associated with a communication device

(Supp. Ans. 4; FF 1-2), and Brackett discloses having job records containing information that is also provided in the corresponding one of the device records (Supp. Ans. 4; FF 3). We agree with the Examiner's finding that the combination of the references discloses job records for servicing.

In the Reply Brief, Appellants add the arguments that "[t]here is no disclosure in Atkin that any print jobs are printed using any communication adaptor" (Reply Br. 7), and that "Atkin does not disclose the specific mechanism used to instruct these devices to perform these jobs" (Reply Br. 8). However, such argument is not commensurate with the invention that is claimed. That is, such "printed using any communication adaptor" and "specific mechanism used to instruct these devices" are not recited in the claims and cannot be read into the claims.

Accordingly, we conclude that the Appellants have not shown that the Examiner erred in rejecting claim 1, and claims 5, 6, 17, 21, 22, and 27 falling with claim 1, under 35 U.S.C. § 103(a).

Dependent claims 2-4, and 18-20

As for claim 2-4 and 18-20, Appellants provide the same argument as claims 1 and 17 from which they depend, and add the argument that "the deficiencies of Pouban, Brackett, and Atkins with respect to the independent claims 1 and 17, discussed above, are not overcome by the addition of the James reference" (App. Br. 12).

We find no deficiencies regarding Pouban and Brackett, as discussed above regarding claims 1 and 17. Therefore, we conclude that Appellants

have not shown that the Examiner erred in rejecting claims 2-4 and 18-20, under 35 U.S.C. § 103(a) over Poublan, Brackett, and James.

CONCLUSION OF LAW

(1) Appellants have not shown that the Examiner erred in finding that claims 1, 5, 6, 17, 21, 22, and 27 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Poublan, Brackett and Atkin.

(2) Appellants have not shown that the Examiner erred in finding that claims 2-4, and 18-20 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Poublan, Brackett, and James.

(3) Claims 1-6, 17-22, and 27 are not patentable.

DECISION

The Examiner's rejection of claims 1-6, 17-22, and 27 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

Appeal 2008-0706
Application 09/891,143

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MUIRHEAD AND SATURNELLI, LLC
200 FRIBERG PARKWAY, SUITE 1001
WESTBOROUGH MA 01581